

REMARKS

By the present amendment, claims 19 and 23-24 have been amended to correct informalities.

In addition, new claims 27-29 have been added. Support for the new claims is found in the original application, in particular in Figure 5 and corresponding description.

Claims 8 and 16-29 are pending in the present application.

As a preliminary, Applicants acknowledge the indication in the Office Action that claim 18 is allowed.

However, in the Office Action, claim 23 is rejected under 35 U.S.C. 112, second paragraph, as indefinite. It is alleged in the Office Action that the term "said woven cloth" lacks antecedent basis.

Claim 23 has been amended to recite "a woven cloth". Accordingly, it is submitted that the rejection should be withdrawn.

Next, in the Office Action, claims 8, 19-21 and 23-26 are rejected under 35 U.S.C. 103(a) as obvious over US 361,849 (Taylor) in view of US 2,890,540 (Britt). It is alleged in the Office Action that one of ordinary skill in the art would be motivated to obtain a damask pattern as shown in Britt without using the embossing roll of Britt, and would possess sufficient knowledge to replace the loose natural fiber fabric by a metallic or plastic fabric because such fabrics are "standards in the industry."

Applicants urge reconsideration and withdrawal of the rejection.

First, regarding claim 23, it is submitted that Taylor fails to teach or suggest a woven cloth disposed in place of the pick-up felt, as recited in present claim 23 (as well as in claim 18 which is considered allowed). Therefore, claim 23 should be considered immediately allowable like claim 18.

Second, regarding the other rejected claims, it is submitted that, contrary to the interpretation set forth in the Office Action, metallic or plastic fabrics are not standards of the industry to obtain damask patterns. Admittedly, Taylor teaches an embossed pattern obtained by using a woven cloth, but Taylor uses a loose natural fiber cloth wholly unsuitable for a complex pattern such a damask. Britt, the only reference cited in the Office Action to obtain damask pattern, recognizes the unsuitability of the cloth used in Taylor, but Britt teaches an engraving roll, not a modified fabric.

The publication dates of Taylor and Britt themselves show that persons of the art did not expect that a damask pattern could be obtained with a woven cloth. Namely, Taylor taught the use of a cloth for patterns as early as 1887. However, as late as 1959, Britt taught the use of an engraving roll, not a modification of Taylor's cloth. In other words, both Taylor and Britt establish that the industry standard, to obtain damask pattern, was the use of an engraving roll, not a fabric.

In addition, EP 0 458 973 (Hiyoshi) does not provide any evidence of an industry standard regarding the use of metallic or plastic cloth for embossed patterns, because Hiyoshi concerns watermarks. The visual effect of a watermark is obtained by differences in the orientation of the fibers, not by an embossed pattern. Thus, if anything, Hiyoshi reinforces the suggestion that a cloth might be appropriate for simple embossed patterns (as in Taylor) or visual effects not affecting substantially the paper surface (as in Hiyoshi), but that a cloth cannot replace an engraving roll for such a complex and intricate design as damask.

In contrast, the present inventors have determined that, by using a metallic or plastic cloth, it is possible to obtain a damask pattern. This feature cannot be said to be obvious over Taylor and Britt, except in hindsight, because Taylor teaches only a loose natural fiber cloth, and Britt teaches

that a damask pattern is obtained by using an engraving roll. Therefore, the present claims are not obvious over any combination of Taylor and Britt.

In view of the above, it is submitted that the rejection should be withdrawn.

Next, in the Office Action, claims 8, 16, 19-22, and 24-26 are rejected under 35 U.S.C. 103(a) as obvious over EP 0 458 973 (Hiyoshi) in view of Britt.

This rejection is also respectfully traversed. As discussed above, Hiyoshi concerns a watermark, not an embossed pattern. Watermarking, which is obtained by modifying the fiber directions, is completely different from embossing, which provides a deformation of the paper surface. Accordingly, Hiyoshi does not provide any teaching as to whether a fabric suitable for obtaining a watermark is also suitable for obtaining an embossed design such as damask pattern. As a result, a person of ordinary skill in the art would not have had any motivation to attempt using the watermark fabric of Hiyoshi to obtain an embossed pattern, let alone a complex pattern like damask. Rather, that person would have followed the teaching of Britt and used an engraving roll. Therefore, the present claims are not obvious over any combination of Hiyoshi and Britt.

In particular, regarding claims 16 and 22, Hiyoshi does not provide any teaching as to whether it would be possible to obtain a damask pattern by using a cloth placed directly on the cylinder. Therefore, for this reason alone, claims 16 and 22 are not obvious over any combination of Hiyoshi and Britt.

In view of the above, it is submitted that the rejection should be withdrawn.

In addition, with respect to new claims 27-29, it is submitted that none of the cited references suggests obtaining a damask pattern with multiple wefts with different slants and shapes, as recited

in these claims. Therefore, for this reason alone, present claims 27-29 are patentable over the cited references taken alone or in any combination.

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

In the event there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to our Deposit Account No. 01-2340.

Respectfully submitted,

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Encl.: Request for Continued Examination